



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/894,035	06/28/2001	Michael Baentsch	CH920000039US1 (14665 )	5498

7590 02/17/2005  
Steven Fischman, Scully,  
Scott, Murphy & Presser  
400 Garden City Plaza  
Garden City, NY 11530

EXAMINER

FAROOQ, MOHAMMAD O

ART UNIT PAPER NUMBER

2182

DATE MAILED: 02/17/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/894,035

Applicant(s)

BAENTSCH ET AL.

Examiner

Mohammad O. Farooq

Art Unit

2182

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 22 August 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☒ Claim(s) 6 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 28 June 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☒ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

1. Claims 13 and 14 construe to be independent claims. Therefore charge deposit account number 50-0510 an amount of \$400.00 for 2 extra independent claim; fee code 1201.

#### ***Claim Objections***

2. Claim 6 is objected to because of the following informalities: there seems to be a typo at line two of this claim; the claim states "... (11, 12, 3) being stored..." This office action treats this as "... (11, 12, 13) being stored...". Appropriate correction is required.

#### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

3. Claims 1-19 are rejected under 35 U.S.C. 102(a) as being anticipated by Nachenberg, U.S. Pat. No. 6,230,316.

Art Unit: 2182

4. As to claim 1, Nachenberg teach method for a software provider (25) of enabling a software-acquiring entity (20) to arrive from an existent first signed piece of code (11) at a second signed piece of code (12,13), both pieces of code (11,12,13) having been granted by use of a first software archive generator (2) under use of generation instructions (8), comprising the step of providing to said software-acquiring entity (20) a difference code (4,5) (i.e. difference between two versions; col. 1, lines 34-52) comprising the steps necessary to arrive from said first signed piece of code (11) at said second signed piece of code (12,13), which difference code (4,5) (i.e. difference between two versions; col. 1, lines 34-52) is usable at said software-acquiring entity (20) to be combined with said first signed piece of code (11) by a second software archive generator (7) to generate said second signed piece of code (11) by a second software archive generator (7) to generate said second signed piece of code (12, 13), whereby said second software archive generator (7) is to be fed with those generation instructions (8) that were used by said first software archive generator (2) for the generation of both pieces of code (11, 12, 13) (abstract; fig. 8; col. 5, line 36- col. 6, line 17).

5. As to claim 2, Nachenberg teach method, wherein the generation instructions (8) are provided to the software-acquiring entity (20) by the software provider (25), preferably together with the second software archive generator (7) (inherent; col. 1, lines 12-26).

Art Unit: 2182

6. As to claim 3, Nachenberg teach method, wherein the pieces of code are signed using a private key (inherent; col. 1, line 65 – col. 2, lines 24).

7. As to claim 4, Nachenberg teach method, wherein the signed pieces of code (11, 12, 13) are stored in a storage unit (1) at the software provider (25) (see fig. 8; col. 1, lines 12 – 59).

8. As to claim 5, Nachenberg teach method, wherein the difference code (4,5) (i.e. incremental updates) is created, preferably by the first software archive generator (2), while said first software archive generator (2) generates the second signed piece of code (12, 13) (inherent; col. 1, line 34 – col. 2, line 24).

9. As to claim 6, Nachenberg teach method, wherein for more than two pieces of code (11, 12, 13) being stored, the difference code (4,5) is generated only between a subset of said pieces of code (11, 12, 13) (inherent; see fig. 8).

10. As to claim 7, Nachenberg teach method, wherein for arriving from the first piece of code (11) to the second piece of code (13) several difference codes (4, 5) are required, these difference codes (4,5) are merged into a single difference code (i.e. update file; see fig. 8) to be provided to the software-acquiring entity (20) (col. 1, line 53 – col. 2, lines 24; col. 5, line 34 – col. 6, line 17).

Art Unit: 2182

11. As to claim 8, Nachenberg teach method, wherein the first and second piece of code (11, 12, 13) are identified at the software provider (25) by deriving a corresponding identifier from a request (16) received from the software-acquiring entity (20) (inherent; col. 1, line 12 – col. 2, line 24).

12. As to claim 9, Nachenberg teach method for a software-acquiring entity (20) of arriving from an existent first signed piece of code (11) at a second signed piece of code (12, 13), both pieces of code (11, 12, 13) having been generated at a software provider (25) by use of a first software archive generator (2) under use of generation instructions (8), comprising the steps of

- sending a code amendment request (16) to said software provider (25) for the delivery of a difference code (4,5) which comprises the steps necessary to arrive from said first signed piece of code (11) at said second signed piece of code (12, 13) (inherent; col 1, lines 34-52),
- receiving said difference code (4,5) (i.e. update; fig. 8; col. 1, line 12 – col. 2, line 24),
- combining said difference code (4,5) with said first signed piece of code (11) by use of a second software archive generator (7), thereby generating said second signed piece of code (12, 13), whereby said second software archive generator (7) is fed with those generation instructions (8) that were used by said first software archive generator (2) for the generation of both pieces of code (11, 12, 13) (col. 1, line 34 – 52; col. 5, line 36 – col. 6, line 17).

Art Unit: 2182

13. As to claim 10, Nachenberg teach method, wherein the generation instructions (8) are received from the software provider (25), preferably together with the second software archive generator (7) (inherent; col. 1, lines 12-26).

14. As to claim 11, Nachenberg teach method, wherein the pieces of code (11, 12, 13) are signed by use of a private key (14) and the signature (Sig 11, Sig 12, Sig 13) is verifiable by use of a corresponding public key (15) (inherent; col. 1, line 65 – col. 2, lines 24).

15. As to claim 12, Nachenberg teach method, wherein the first and second pieces of code (11, 12, 13) are identified by the software-acquiring entity (2) by giving a corresponding identifier in the code amendment (i.e. update) request (16) (col. 1, line 12 – col. 2, line 24; col. 5, line 34 – col. 6, line 17).

Art Unit: 2182

16. As to claim 13, Nachenberg teach computer program product for a software provider (25) of enabling a software-acquiring entity (20) to arrive from an existent first signed piece of code (11) at a second signed piece of code (12,13), both pieces of code (11,12,13) having been granted by use of a first software archive generator (2) under use of generation instructions (8), comprising the step of providing to said software-acquiring entity (20) a difference code (4,5) (i.e. difference between two versions; col. 1, lines 34-52) comprising the steps necessary to arrive from said first signed piece of code (11) at said second signed piece of code (12,13), which difference code (4,5) (i.e. difference between two versions; col. 1, lines 34-52) is usable at said software-acquiring entity (20) to be combined with said first signed piece of code (11) by a second software archive generator (7) to generate said second signed piece of code (11) by a second software archive generator (7) to generate said second signed piece of code (12, 13), whereby said second software archive generator (7) is to be fed with those generation instructions (8) that were used by said first software archive generator (2) for the generation of both pieces of code (11, 12, 13) (abstract; fig. 8; col. 5, line 36- col. 6, line 17).

17. As to claim 14, Nachenberg teach computer program product, wherein the first and second pieces of code (11, 12, 13) are identified by the software-acquiring entity (2) by giving a corresponding identifier in the code amendment (i.e. update) request (16) (col. 1, line 12 – col. 2, line 24; col. 5, line 34 – col. 6, line 17).



Art Unit: 2182

18. As to claim 15, Nachenberg teach code amendment enabler comprising
- a difference code generator (10) for generating a difference code (4,5) that comprises the steps necessary to arrive from said first signed piece of code (11) at said second signed piece of code (12, 13), which difference code (4,5) is usable at said software-acquiring entity (2) to be combined with said first signed piece of code (11) by a second software archive generator (7) to generate said second signed piece of code (12, 13), whereby said second software archive generator (7) is fed with the generation instructions (8) (abstract; fig. 8; col. 1, line 12- col. 6, line 24; col. 5, line 36 – col. 6, line 17),
  - an output unit (3) for providing to said software-acquiring entity (2) said difference code (4,5) (inherent; see fig. 8; col. 5, line 36 – col. 6, line 17).

19. As to claim 16, Nachenberg teach code amendment enabler, further comprising an input unit (24) (inherent) for receiving from said software-acquiring entity (20) a code amendment request (16) for the delivery of said difference code (4,5) (col. 5, line 36 – col. 6, line 17).

20. As to claim 17, Nachenberg teach code amendment enabler, further comprising a first software archive generator (2) for generating said pieces of code (11, 12, 13) under use of generation instructions (8) (col. 1, lines 12 – 65).

Art Unit: 2182

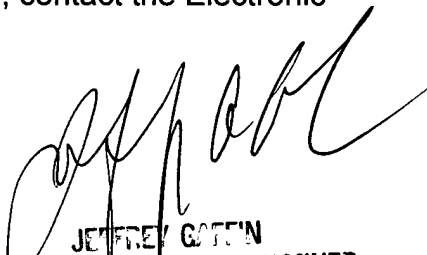
21. As to claim 18, Nachenberg tech code amendment device, comprising
- a second software archive generator (7) for combining a received difference code (4,5) with said first signed piece of code (11), thereby generating said second signed piece of code (12, 13) , whereby said second software archive generator (7) is to be fed with those generation instructions (8) that were used by said first software archive generator (2) for the generation of both pieces of code (11, 12, 13) (inherent; col. 1, line 12 – col. 2, line 24; col. 5, line 36 – col. 6, line 17).
22. As to claim 19, Nachenberg teach code amendment device, further comprising an input/output unit (6) for sending a code amendment request (16) to said software provider (25) and for receiving said difference code (inherent since updates are developed and sent via floppy or CD-ROMs; col. 1, line 12 – 26).

Art Unit: 2182

23. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mohammad O. Farooq whose telephone number is (571) 272-4144. The examiner can normally be reached on 9:00am - 5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey A. Gaffin can be reached on (571) 272-4146. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



JEFFREY GAFFIN  
SUPERVISOR, PATENT EXAMINER  
TECHNOLOGY CENTER 2100

Mohammad O. Farooq  
February 12, 2005